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Law Offices of John D. Gugliotta, P.E., Esq. 202 Delaware Building 137 South Main Street Akron, OH 44308			BOTTORFF, CHRISTOPHER	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/774,962

Filing Date: January 31, 2001

Appellant(s): MCCOLLUM ET AL.

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John D. Gugliotta  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed to Appellant's Brief on Appeal filed June 11, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is incorrectly presented under the heading "Statement of Amendments." A correct statement of the status of the claims is as follows: Claims 1-8 were finally rejected and are the subject of this appeal.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is substantially correct. However, since the patent to Pratt et al. was not cited in the final rejection, no rejection in view of Pratt et al. can form an issue for this appeal. Consequently, issue 5 should state: Is claim 8 unpatentable under 35 U.S.C. 103(a) by Allen in view of Inge or Server Perez in view of Inge? Also, the rejection of claims 1 and 6 under 35 U.S.C 102(b) as being anticipated by Allen is not listed as an issue. Issue 6 should state: Are claims 1 and 6 anticipated under 35 U.S.C. 102(b) by Allen?

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 6; 3; 4; 8; and 1, 2, 5, and 7 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). The reasons as to why claim 6 does not stand or fall with the other claims are provided in the third paragraph of page 10 in the arguments section of the brief. Although claim 6 is not specifically identified, the arguments of the third paragraph on page 10 are directed toward the limitations of claim 6.

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

US 3,934,895	FOX	1-1976
US 4,989,889	SERVER PEREZ	2-1991

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US 5,845,780	ALLEN	12-1998
US 6,386,557	WELDON	5-2002
US 5,951,075	GREEN	9-1999
US 6,494,468	INGE	12-2002

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipate by Fox US 3,934,895.

Fox discloses a wheeled, portable, collapsible athletic equipment carrier comprising a two wheeled cart and an athletic bag incorporating the cart. See Figure 1 and note wheels 24, bag 8, and collapsible handle 32. The bottom end of the athletic bag rests against a base member 12 of the cart such that a bag mounting platform is formed that serves as a base upon which a base of the bag is permanently attached. See column 1, line 65, through column 2, line 5.

Claims 1, 2, 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Server Perez US 4,989,889.

Server Perez discloses a wheeled, portable, collapsible equipment carrier comprising a two wheeled cart and a bag 6 incorporating the cart. See Figures 1-4, and note the wheels mounted to frame member 9 and the collapsed configuration depicted

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in figure 2. A main frame 2, 5, and 9 has an anterior end opposite a posterior end and includes a hollow, tubular base member 9 forming a U-shape that serves as a base upon which the bag can be supported. An elongated, hollow, tubular handle 1 and 4 formed of a U-shape is pivotally mounted at sleeve 3 to inside circumferential sidewalls 2 of the main frame at the anterior end. See Figures 1, 3, and 4. The bottom end of the athletic bag rests against a base member of the cart such that a bag mounting platform is formed that serves as a base upon which a base of the bag is permanently attached. Note in Figure 2 that the bag remains permanently attached even when the carrier is collapsed.

Also, identifying the carrier as being used for athletic purposes does not distinguish the invention over the prior art. It is well settled that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danley*, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device *is*, not what it *doesHewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original). Moreover, a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all of the structural limitations of the claim *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Here, Server Perez teaches all of the structural limitations claimed and is capable of being used for athletic purposes.

Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen US 5,845,780.

Allen discloses a wheeled, portable, collapsible athletic equipment carrier 10 comprising a two wheeled cart (note the handle and wheel arrangement depicted in figures 1 and 3) and an athletic bag incorporating the cart. See figures 1-3. The bag has a generally vertically elongated configuration fabricated of a fabric that is heavy, flexible, and weatherproof. See column 2, lines 48-49.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Server Perez US 4,989,889 in view of Weldon US 6,386,557.

Server Perez does not disclose a support stand having an elongated, hollow, cylindrical U-shaped configuration affixed to lower external circumferential sidewalls of the base member. However, Weldon teaches the old and well known cart frame configuration having a main frame 10 with an anterior end opposite a posterior end, a hollow and tubular base member 16 forming a U-shape, and a support stand 17 with an elongated, hollow, cylindrical U-shaped configuration affixed to lower circumferential sidewalls of the U-shaped portion of the base member at corners. See Figures 1-3. From the teachings of Weldon, forming the frame of Server Perez with a support stand that is elongated, hollow, cylindrical, U-shaped, and is affixed to lower circumferential sidewalls of the U-shaped portion of a hollow and tubular base member would have been obvious to one of ordinary skill in the art at the time the invention was made. This would provide a sturdy base of support for the bag.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Server Perez US 4,989,889 in view of Green US 5,951,075.

Server Perez does not disclose an inflating pump attached to the equipment carrier. However Green teaches that inflating pumps are old and well known pieces of equipment that are commonly carried with equipment carriers. See column 6, lines 24-26. From the teaching of Green, attaching a pump to the carrier of Server Perez would have been obvious to one of ordinary skill in the art at the time the invention was made in order to service other equipment attached to or carried by the carrier.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen US 5,845,780 in view of Green US 5,951,075.

Allen does not disclose an inflating pump attached to the equipment carrier. However Green teaches that inflating pumps are old and well known pieces of equipment that are commonly carried with equipment carriers. See column 6, lines 24-26. From the teaching of Green, attaching a pump to the carrier of Allen would have been obvious to one of ordinary skill in the art at the time the invention was made in order to service other equipment attached to or carried by the carrier.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Server Perez US 4,989,889 in view of Inge US 6,494,468.

Server Perez also does not disclose ball-receiving cylinders attached to the front side of the bag. However, Inge teaches that the practice of attaching a ball-receiving cylinder 12 to the front side of a carrier was old and well known in the art at the time the invention was made. Also, the dimensions of the cylinder are suitable for accommodating softballs and/or baseballs 13. See Figure 1 and column 3, lines 24-29. Providing the bag of Server Perez with a ball-receiving cylinder would have been obvious to one of ordinary skill in the art at the time the invention was made in order to hold balls that are used with the athletic equipment in the bag.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen US 5,845,780 in view of Inge US 6,494,468.

Allan also does not disclose ball-receiving cylinders attached to the front side of the bag. However, Inge teaches that the practice of attaching a ball-receiving cylinder 12 to the front side of a carrier was old and well known in the art at the time the invention was made. Also, the dimensions of the cylinder are suitable for accommodating softballs and/or baseballs 13. See Figure 1 and column 3, lines 24-29. Providing the bag of Allan with a ball-receiving cylinder would have been obvious to one of ordinary skill in the art at the time the invention was made in order to hold balls that are used with the athletic equipment in the bag.

**(11) Response to Argument**

A. Rejections under 35 U.S.C. 102(b)

Appellant's sole argument directed toward the rejections of claims 1, 2, 5, 6, and 7 as being anticipated under 35 U.S.C. 102(b) is presented in the second full paragraph on page 8 of the brief and states that both Fox and Server Perez "fail to *claim* an athletic bag incorporating a *cart*." (emphasis in original) This conclusion is based upon an inaccurate interpretation of the legal standards governing anticipation. Appellant presents the legal standards established by two decisions of the U.S. Court of Appeals for the Federal Circuit, which are as follows:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki motor Co., 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Appellant's argument suggests that the "claim" to which the court refers is the claim of the prior art reference, and that the prior art reference must claim the identical invention claimed by Appellant. However, in general, not all prior art references are patents and not all prior art references have claims. Thus, the "claim" to which the court refers in the general rule cannot be the claims of the prior art. Accordingly, the court does not require a prior art reference to claim the identical invention claimed by Appellant.

Rather, in regard to the determination of patentability of Appellant's claims, the "claim" stated by the court refers to Appellant's claim, not claims of the prior art. The prior art reference must describe, either expressly or inherently, each and every

element set forth in Appellant's claim. This description can be found throughout the prior art reference, not only in claims that may be presented in the reference.

The prior art references cited by the examiner in support of the anticipation of claims 1, 2, and 5-7 describe, either expressly or inherently, each and every element set forth in Appellant's claim. For example, the full disclosure of Fox describes a wheeled, portable, collapsible athletic equipment carrier comprising a two wheeled cart 10 and an athletic bag 8 incorporating the cart 10. This is described by Figures 1 and 3.

The full disclosure of Server Perez describes a wheeled, portable, collapsible equipment carrier comprising a two wheeled cart and a bag 6 incorporating the cart. This is described by Figures 1-4. A main frame 2, 5, and 9 has an anterior end opposite a posterior end and includes a hollow, tubular base member 9 forming a U-shape that serves as a base upon which the bag 6 can be supported. Figure 1 provides this description. An elongated, hollow, tubular handle 1 and 4 formed of a U-shape is pivotally mounted at sleeve 3 to inside circumferential sidewalls 2 of the main frame at the anterior end. This is described by Figures 1, 3, and 4. The bottom end of the athletic bag 6 rests against a base member 5 of the cart such that a bag mounting platform is formed that serves as a base upon which a base of the bag is permanently attached. Figures 1-3 describe this.

Appellant's claim 1 indicates that the equipment carrier is intended to be employed for athletic purposes and Server Perez does not specifically state that his equipment carrier is intended to be employed for athletic purposes. However, a claim containing a "recitation with respect to the manner in which a claimed apparatus is

intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all of the structural limitations of the claim *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Here, Server Perez teaches all of the structural limitations claimed and is capable of being used for athletic purposes.

In regard to Allen, Appellant addresses Allen and the limitations of claim 6 on page 10 of the brief under the heading "Rejections under 35 U.S.C. 103(a)." However, these arguments are relevant to the rejection of claims 1 and 6 under 35 U.S.C. 102(b) as being anticipated by Allen, and not to the rejections under 35 U.S.C. 103(a). As such, the examiner's response to these arguments is provided in the following paragraphs, rather than in regard to the determination of obviousness.

The full disclosure of Allen describes a wheeled, portable, collapsible athletic equipment carrier 10 comprising a two wheeled cart and an athletic bag incorporating the cart. The cart comprises back wall 16, handle 28 attached to back panel 16, and wheels 29 at the edge of bottom 26. This is described in Figures 1-3 and column 2, lines 48-51, 56-58, and 60-62. The bag comprises fabric enclosure 12, which is described in column 2, lines 48-51. In that the fabric of fabric enclosure 12 can provide the contents of the bag with protection from the weather, the fabric is weatherproof. In that the fabric of fabric enclosure 12 has weight and can fold when the panels move between open and closed positions, the fabric is heavy and flexible.

Appellant's arguments asserting that the fabric disclosed by Allen is not weatherproof, flexible, or heavy suggest that Appellant's fabric is better at resisting

weather, is more flexible, and has greater weight than the fabric of Allen. However, this is a distinction of degree, and claim 6 does not define the extent to which the fabric must be weatherproof, flexible, and heavy. Any unique properties possessed by Appellant's fabric that are not possessed by the fabric of Allen are not captured by the expression "weatherproof, flexible, and heavy."

Under the broadest reasonable interpretation of claim 6, "weatherproof" only requires the fabric to resist the weather to an appreciable, but unstated degree. The fabric of Allen inherently resists weather to this extent. "Flexible" only requires that the fabric be capable of being bent. Since the fabric of Allen moves, it can be bent. "Heavy" only requires that the weight of the fabric be great relative to another fabric. In order to be sufficiently durable for athletic purposes, the weight of the fabric of Allen would necessarily be greater than many other fabrics, such as delicate silk and the like.

Therefore, Fox, Server Perez and Allen describe, either expressly or inherently, each and every element set forth in the claims of Appellant to which each reference was respectively directed. Whether or not these references claim specific limitations found in Appellant's claim is irrelevant.

B. Rejections under 35 U.S.C. 103(a)

The question of obviousness relates to Appellant's claims 3, 4, and 8 only. In addressing the combinations of Server Perez in view of Weldon, Server Perez in view of Green, Server Perez in view of Inge, Allen in view of Green, and Allen in view of Inge, Appellant addresses each reference individually on pages 9 and 10 of Appellant's brief.

However, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Consequently, Appellant's arguments directed to the references individually fail to establish that the combinations cited by the examiner do not demonstrate the obvious nature of the invention defined in Appellant's claims 3, 4, and 8.

Moreover, these arguments directed to the references individually do not address the limitations of claims 3, 4, and 8 to which the examiner's determination of obviousness is directed. In particular, the rejection of claim 3 indicates that, based upon the teachings of Weldon, modifying the frame of Server Perez with a support stand that is elongated, hollow, cylindrical, U-shaped, and is affixed to lower circumferential sidewalls of the U-shaped portion of a hollow and tubular base member would have been obvious to one of ordinary skill in the art at the time the invention was made. Appellant addresses the examiner's determination of obviousness on lines 5-10 of page 9 of the brief by stating that "Weldon fails to teach an athletic bag..." and "Weldon fails to teach an inflating pump." However, whether or not Weldon teaches an athletic bag or inflating pump is irrelevant since Weldon is not relied upon for such a teaching and claim 3 does not involve an inflating pump. Weldon is relied upon for teaching certain frame features, and obviates the claimed invention when combined with the apparatus of Server Perez.

The rejection of claim 4 indicates that, based upon the teachings of Green, attaching a pump to the carriers of either Server Perez or Allen would have been

obvious to one of ordinary skill in the art at the time the invention was made. Appellant responds to this conclusion of obviousness in the last paragraph on page 9 of the brief by discussing the claimed back carried apparatus and wand of Green without addressing the pump teaching. Although Green teaches additional components that are unrelated to the inflating pump, these components are not applicable to the above rejection. The teaching of the inflating pump directly relates to the limitations of claim 4, and when combined with the additional teachings of either Server Perez or Allen, obviates the invention defined in claim 4. Other features of the present invention that are not defined in claim 4 are irrelevant to the cited combinations involving Green.

Furthermore, the arguments directed to Pratt et al. are not appropriate since the patent to Pratt et al. was not applied to any of the claims in the final rejection and is not an issue in this Appeal. In addition, Appellant does not provide any arguments directed to Inge as applied to claim 8.

Appellant's final argument in regard to obviousness, as presented on pages 10-12 of the brief, asserts that there is no suggestion in the references cited by the examiner for the proposed combinations. However, Weldon, Green, and Inge each provide suggestions for the combinations with which they are each involved.

Weldon suggests the desirability of providing a cart with a main frame 10 having an anterior end opposite a posterior end, a hollow and tubular base member 16 forming a U-shape, and a support stand 17 with an elongated, hollow, cylindrical U-shaped configuration affixed to lower circumferential sidewalls of the U-shaped portion of the base member at corners. This is described in figures 1-3. The desirability of having

such a frame structure on a cart sufficiently suggests the value of utilizing such a frame on the cart of Server Perez in order to provide a sturdy base of support for the bag of Server Perez.

Green suggests the desirability of attaching a pump to an equipment carrier in column 6, lines 24-26. This desirability of attaching a pump to an equipment carrier sufficiently suggests the value of attaching a pump on the equipment carriers of either Server Perez or Allen in order to service other equipment attached to or carried by the carrier.

Inge suggests the desirability of attaching a ball-receiving cylinder 12 to the front side of a carrier and providing the dimensions of the cylinder 12 are suitable for accommodating softballs and/or baseballs 13. This is described in Figure 1 and column 3, lines 24-29. This desirability of attaching a ball-receiving cylinder to the front side of a carrier sufficiently suggests the value of attaching a ball-receiving cylinder to the front side of the bag of either Server Perez or Allen in order to hold balls that are used with the equipment in the bag.

Although the suggestions presented in the preceding paragraphs were presented in the final rejection, Appellant has not explained how they fail to support their respective combinations outlined in the final rejection. In fact, each of Weldon, Green, and Inge provides suggestion for their respective combinations, and these suggestions are evidence that support a *prima facie* case of obviousness without the use of hindsight gained through Appellant's disclosure.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Christopher Bottorff  
August 27, 2004

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